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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,193	12/21/2000	Rudolph W. Frey	24430.9	7612

7590

12/30/2002

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EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

9

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on August 27, 2002
- ☒ This action is FINAL.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-11 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-11 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bille et al.

Claims 1 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knopp et al in combination with Young et al. Knopp et al teach an eye tracker with a high rate of tracking and infrared tracking. Young et al teach the equivalence of various methods of eye tracking including two axis sensing of the iris pupil boundary. It would have been obvious to the artisan of ordinary skill to employ the two axis tracking method of Young et al in the device of Knopp et al, since this is equivalent to other tracking methods, thus producing a method such as claimed.

Claims 2 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklar et al in combination with Isakov et al. Sklar et al teach a device as claimed except the specifically shifting of the beam resulting in a resulting beam path parallel to the original beam path. Isakov et al teach a laser scanning method wherein the beam path at any given scan location is parallel to the beam paths of all previous scan locations. It would have been obvious to the artisan of ordinary skill to employ the scanning method of Isakov et al in the method of Sklar et al, since Sklar et al teach no particular method for scanning the beam between points on the tissue, thus producing a method such as claimed.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,632,742. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5,849,006. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of copending Application No. 09/742,884. Although the conflicting claims are not identical, they are not patentably distinct from each other because ~~Although the conflicting claims are not identical, they are not patentably distinct from each other because~~ the claims are merely an obvious change in scope. This is a ~~distinct~~ 2

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provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 5,980,513. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-44 of U.S. Patent No. 09/742,885. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of copending Application No. 09/745,191. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are merely an obvious change in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant argues that because Bille does not mention plumes, there can be no inherency in a lack of interference with adjacent pulse plumes. It is not clear how applicants conclusion follows from the premis, since if it were recommended that one weeks time elapsed between pulses, in order to fully evaluate the effect of each pulse would clearly inherently fulfil the lack of

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interference with adjacent pulse plumes, without making any mention thereof. In similar fashion, the teaching of minimizing the peripheral effects, which requires that the longest possible time pass (e.g. one eighth of the total procedure time) pass before placing an adjacent shot to any other shot. Further, in the case of the internal ablation, since the plume would be contained within the ablation volume, this would also inherently not interfere with a subsequent ablation. Thus these arguments are not convincing.

With respect to the combination involving Isakov, the examiner respectfully directs applicants attention to Figure 2 thereof, which clearly shows a scanner. The argument regarding Sklar is not understood as no source 21 has been found by the examiner therein.

Applicant's arguments filed August 27, 2002 have been fully considered but they are not persuasive. The arguments are not convincing for the reasons set forth above.

Applicant's arguments with respect to claims 1 and 5-8 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.



DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330

David Shay:lf  
December 16, 2002